

Remarks

The present application includes claims 1-78, all of which have been rejected.

The Applicants respectfully request reconsideration of the claim rejections for the reasons set forth below.

Initially, the Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicants assume, based on the goals of patent examination noted above, that the Office Action has set forth "all reasons and bases" for rejecting the claims.

I. Identification Of At Least One Error

The Office Action states that the reissue oath/declaration filed with the application is defective because it fails to identify at least one error which is relied upon to support the reissue application. *See* 4/28/2005 Office Action at page 2. Additionally, the Office Action asserts that the oath/declaration is defective because it fails to identify at least one error which is relied upon to support the reissue application. *See id.* The Applicants have submitted a Supplemental Reissue Declaration By The Inventors to overcome these issues. The Applicants respectfully submit that the Supplemental Reissue Declaration clearly and particularly identifies at least one error that is relied upon to support the reissue application.

The Manual of Patent Examining Procedure (MPEP) states the following:

The most common bases for filing a reissue application are:

(A) **the claims are too narrow or too broad;**...

See MPEP at § 1402 (emphasis added). Additionally, the MPEP states the following:

A change or departure from the original specification or claims represents an “error” in the original patent under 35 U.S.C. 251.

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Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied.

* * *

All that is needed for the oath/declaration statement as to error is the identification of “at least one error” relied upon.

* * *

Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.

See MPEP at § 1414(II).

The Applicants believe that they did identify an error in the original declaration.

In particular, the declaration states the following:

One error being relied upon as the basis for reissue is the previous omission of claims 30-40, which are presented in the preliminary amendment mentioned above. I understand that at least claim 30 is broader than any claim in the original patent.

See Declaration at page 2. Nevertheless, to expedite prosecution of the present application, the Applicants have submitted a Supplemental Reissue Declaration, in which at least one error is identified with particularity.

In particular, the Supplemental Declaration states the following:

[C]laim 30 is broader than claim 12 of the original patent. Claim 30 recites "first and second raceway panels disposed adjacent to one another in the concrete floor." Claim 30 does not recite that "each raceway panel" has "a top wall, a bottom wall and a pair of side walls defining an interior passage," such as is recited in claim 12.

See Supplemental Reissue Declaration By The Inventors. The Applicants note that a "claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least one* respect, even though it may be narrower in other respects."

MPEP at § 1412.03. Thus, the Applicants respectfully submit that an error has been clearly and particularly identified in the reissue application.

II. Claims 30-78 Should Be In Condition For Allowance

Claims 30-78 were rejected under 35 U.S.C. 251 as being based upon new matter. The amendment filed on November 3, 2003 is objected to under 35 U.S.C. 132(a) because it allegedly introduces new matter into the disclosure. Finally, claims 30-78 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description. The Applicants respectfully traverse these rejections and objection for the reasons set forth below.

The Office Action asserts that the following are not supported by the prior patent:

1. In claim 30, lines 3-4, "first and second raceway panels disposed adjacent to one another in the concrete floor";
2. In claim 30, lines 7-8, "at least one clip engageable with the first and second housings to secure the first and second housings to one another";
3. In claim 33, lines 4-9, "a housing securable... a plurality of wire retention clips mounted around the perimeter of the opening... through the opening";
4. In claim 41, lines 5-8, "a housing interconnector located proximate... to interconnect said housing to another housing";
5. In claim 54, lines 4-13, "first and second rectangular housings... an alignment device that securably engages one of said housing interconnectors... second rectangular housing together"; and
6. In claim 66, lines 3-14, "first and second raceway panels disposed adjacent to one another... an alignment device that securably engages one of said housing interconnectors... second housing together."

See April 28, 2005 Office Action at pages 2-3. The objection to the specification under 35 U.S.C. 132(a) and the rejection of claims 30-78 under 35 U.S.C. 112, first paragraph, are based on the same. See *id.* at pages 3-5. The Applicants respectfully submit, however, that there is clearly support for claims 30-78 of the present application in the original patent, as shown below.

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The Applicants first turn to “first and second raceway panels disposed adjacent to one another in the concrete floor,” as recited in claim 30, lines 3-4. An example of support for this claim limitation in United States Patent No. 6,315,725 is shown below, with emphasis added:

Claim Limitation	Support In USP 6,316,725 (the “’725 patent”)
first and second raceway panels disposed adjacent to one another in the concrete floor;	<p>“[A]n underfloor electrical distribution system 10 includes a plurality of raceway panels 12... that are adapted to be positioned on a subfloor prior to pouring of the concrete floor 13.” ‘725 patent at column 3, lines 9-12.</p> <p>“In addition to interconnecting the presets 24, the alignment clips 60 maintain a uniform space between the presets 22 and hence the adjacent raceway panels 12.” <i>Id.</i> at column 5, lines 1-4.</p>

Thus, the Applicants respectfully submit that there is clearly support for this claim limitation in the ‘725 patent.

The Applicants next turn to “at least one clip engageable with the first and second housings to secure the first and second housings to one another,” as recited in claim 30, lines 7-8. An example of support for this claim limitation in United States Patent No. 6,315,725 is shown below, with emphasis added:

Claim Limitation	Support In USP 6,316,725 (the "'725 patent")
<p>at least one clip engageable with the first and second housings to secure the first and second housings to one another.</p> <p style="text-align: center;"><i>X</i></p>	<p>"FIGS. 9 and 10 illustrate the use of alignment clips 60 to interconnect and align presets..." <i>Id.</i> at column 4, lines 62-63.</p> <p>"In addition to interconnecting the presets 24, the alignment clips 60 maintain a uniform space between the presets 22 and hence the adjacent raceway panels 12." <i>Id.</i> at column 5, lines 1-4.</p>

Thus, the Applicants respectfully submit that there is clearly support for this claim limitation in the '725 patent.

The Applicants next turn to "a housing securable... a plurality of wire retention clips mounted around the perimeter of the opening... through the opening," as recited in claim 33, lines 4-9. An example of support for this claim limitation in United States Patent No. 6,315,725 is shown below, with emphasis added:

Claim Limitation	Support In USP 6,316,725 (the "'725 patent")
<p>a housing securable to the raceway panel, the housing defining an interior compartment and including an opening alignable with a reciprocal opening in the raceway panel to allow wires to pass between the raceway panel and the interior compartment of the housing; and</p>	<p>"This invention relates generally to underfloor electrical distribution systems, and, more particularly, to improved underfloor preset and afterset housings." <i>Id.</i> at column 1, lines 15-17.</p> <p>"The preset 24 defines a hollow interior compartment 26 that is interconnectable with the interior passage 20 of the raceway panel 12." <i>Id.</i> at column 3, lines 26-30.</p> <p>"Presets 24... are configured to be mounted in the preset openings 22 and to provide access to interior passage 20 of the raceway 12 from the upper surface of the concrete floor 13." <i>Id.</i> at column 3, lines 23-26.</p>

Claim Limitation	Support In USP 6,316,725 (the "'725 patent")
	<i>See also, e.g.,</i> Figures 12-18i of the '725 patent.

Thus, the Applicants respectfully submit that there is clearly support for this claim limitation in the '725 patent.

The Applicants next turn to "a housing interconnector located proximate... to interconnect said housing to another housing," as recited in claim 41, lines 5-8. An example of support for this claim limitation in United States Patent No. 6,315,725 is shown below, with emphasis added:

Claim Limitation	Support In USP 6,316,725 (the "'725 patent")
<p>X</p> <p>a housing interconnector located proximate each of said four corners of said generally rectangular body, wherein said housing interconnector is configured to be engaged by an alignment device that is adapted to interconnect said housing to another housing.</p>	<p>"This invention relates generally to underfloor electrical distribution systems, and, more particularly, to improved underfloor preset and afterset housings." <i>Id.</i> at column 1, lines 15-17.</p> <p>"FIGS. 9 and 10 illustrate the use of alignment clips 60 to interconnect and align presets...." <i>Id.</i> at column 4, lines 62-63.</p> <p>"In addition to interconnecting the presets 24, the alignment clips 60 maintain a uniform space between the presets 22 and hence the adjacent raceway panels 12." <i>Id.</i> at column 5, lines 1-4.</p> <p>"Each alignment clip 60 has an upper portion 61 and three legs 62, 64, 66 extending downwardly from the upper portion. The legs 62, 64, 66 are separated by vertical slots 68, 70 which are configured to engage around tabs 72 that extend from the corners of the presets 24." <i>See id.</i> at column 4, line 64 to column 5, line 1.</p>

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Thus, the Applicants respectfully submit that there is clearly support for this claim limitation in the '725 patent.

The Applicants next turn to "first and second rectangular housings... an alignment device that securably engages one of said housing interconnectors... second rectangular housing together," as recited in claim 54, lines 4-13. Examples of support for these claim limitations in United States Patent No. 6,315,725 are shown below, with emphasis added:

Claim Limitation	Support In USP 6,316,725 (the "'725 patent")
first and second rectangular housings, each of said first and second rectangular housings comprising:	<p>"In the illustrated embodiment, the preset 24 has a generally rectangular housing consisting of a bottom wall 30, an upstanding side wall 32 defining a top opening...." <i>Id.</i> at column 3, lines 29-32.</p> <p><i>See also, eg.,</i> Figures 12-18i of the '725 patent.</p>
four upright walls integrally formed with a bottom wall defining a top opening therebetween and four corners; and	<p>"In the illustrated embodiment, the preset 24 has a generally rectangular housing consisting of a bottom wall 30, an upstanding side wall 32 defining a top opening...." <i>Id.</i> at column 3, lines 29-32.</p> <p><i>See also, e.g.,</i> Figures 12-18i of the '725 patent.</p>
housing interconnectors, wherein at least one of said housing interconnectors is located proximate one of said four corners such that at least one of said housing interconnectors is located proximate each of said four corners, and	<p>"FIGS. 9 and 10 illustrate the use of alignment clips 60 to interconnect and align presets...." <i>Id.</i> at column 4, lines 62-63.</p> <p>"In addition to interconnecting the presets 24, the alignment clips 60 maintain a uniform space between the presets 22 and hence the adjacent raceway panels 12." <i>Id.</i> at column 5, lines 1-4.</p> <p>"Each alignment clip 60 has an upper portion 61 and three legs 62, 64, 66 extending downwardly from the upper</p>

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Claim Limitation	Support In USP 6,316,725 (the "'725 patent")
	portion. The legs 62, 64, 66 are separated by vertical slots 68, 70 which configured to engage around tabs 72 that extend from the corners of the presets 24." See <i>id.</i> at column 4, line 64 to column 5, line 1.
an alignment device that securably engages one of said housing interconnectors of said first rectangular housing and another of said housing interconnectors of said second said rectangular housing to gang said first and second rectangular housings together.	"Alignment clips allow the afterset housings to be ganged together to form an integral afterset assembly." <i>Id.</i> at column 2, lines 9-10.

Thus, the Applicants respectfully submit that there is clearly support for these claim limitations in the '725 patent.

The Applicants finally turn to "first and second raceway panels disposed adjacent to one another... an alignment device that securably engages one of said housing interconnectors... second housing together," as recited in claim 66, lines 3-14. Examples of support for these claim limitations in United States Patent No. 6,315,725 are shown below, with emphasis added:

Claim Limitation	Support In USP 6,316,725 (the "'725 patent")
first and second raceway panels disposed adjacent to one another in the concrete floor;	<p>"[A]n underfloor electrical distribution system 10 includes a plurality of raceway panels 12... that are adapted to be positioned on a subfloor prior to pouring of the concrete floor 13." '725 patent at column 3, lines 9-12.</p> <p>"In addition to interconnecting the presets 24, the alignment clips 60 maintain a uniform space between the presets 22 and hence the adjacent raceway panels 12." <i>Id.</i> at column 5, lines 1-4.</p>

Claim Limitation	Support In USP 6,316,725 (the "725 patent")
a first housing secured to said first raceway panel and a second housing secured to said second raceway panel, wherein each of said first and second housings comprises:	<i>See id.</i> , e.g., Figure 1.
four upright walls integrally formed with a bottom wall defining a top opening therebetween and first, second, third and fourth corners; and	<p>"In the illustrated embodiment, the preset 24 has a generally rectangular housing consisting of a bottom wall 30, an upstanding side wall 32 defining a top opening...." <i>Id.</i> at column 3, lines 29-32.</p> <p><i>See also, eg.</i>, Figures 12-18i of the '725 patent.</p>
first, second, third and fourth housing interconnectors, wherein said first, second, third and fourth housing interconnectors are located proximate said first, second, third and fourth corners, respectively, and	<p>"FIGS. 9 and 10 illustrate the use of alignment clips 60 to interconnect and align presets...." <i>Id.</i> at column 4, lines 62-63.</p> <p>"In addition to interconnecting the presets 24, the alignment clips 60 maintain a uniform space between the presets 22 and hence the adjacent raceway panels 12." <i>Id.</i> at column 5, lines 1-4.</p> <p>"Each alignment clip 60 has an upper portion 61 and three legs 62, 64, 66 extending downwardly from the upper portion. The legs 62, 64, 66 are separated by vertical slots 68, 70 which configured to engage around tabs 72 that extend from the corners of the presets 24." <i>See id.</i> at column 4, line 64 to column 5, line 1</p>
an alignment device that securably engages one of said housing interconnectors of said first housing and another of said housing interconnectors of said second housing to gang said first and second housings together.	<p>"Alignment clips allow the afterset housings to be ganged together to form an integral afterset assembly." <i>Id.</i> at column 2, lines 9-10.</p>

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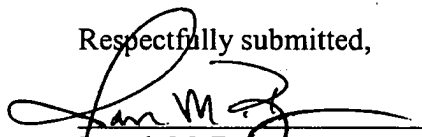
Thus, the Applicants respectfully submit that there is clearly support for these claim limitations in the '725 patent.

III. Conclusion

The Applicants respectfully submit that the claims are supported by the disclosure of the patent as shown above, and are in condition for allowance. As such, the Applicants respectfully request reconsideration of the objections and rejections noted above. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone listed below. The Commissioner is authorized to charge any necessary fees or credit any overpayment to Account No. 13-0017.

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Respectfully submitted,



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